

**REMARKS**

The indication of the presence of allowable subject matter in claims 1-34 is acknowledged with appreciation. By this amendment, claim 35 has been amended to adopt the Examiner's helpful suggestion to insert the word "therapeutically" before the word "effective". No other changes are made by this amendment.

The rejection of claim 35 under 35 U.S.C. §112, first paragraph, for alleged lack of enablement is respectfully traversed. The rejection acknowledges that the treatment of pain is enabled, but asserts that inhibition of pain is not.

By way of explanation, the office action states: "There are numerous mechanisms involved in the etiology of pain and therefore, correcting one of these several mechanism (sic) will not inhibit ( completely cure ) pain." The alleged lack of enablement thus is based on the belief that inhibition of pain requires pain to be completely cured or entirely eliminated. This is not correct. Submitted herewith as an appendix is a three page printout from the webpage *Dictionary.com* which provides definitions of the word "inhibit" from five different dictionaries of the English language. From these accepted dictionary definitions it can be seen that to inhibit means only to decrease, reduce, retard or limit the range or extent of something. Although total elimination of pain (100% inhibition) would fall within the scope of the term inhibiting, it is significant that none of the dictionaries restricts the meaning of inhibiting to require a complete cure or total elimination. To the contrary, inhibiting pain embraces any reduction or suppression of pain, even if it is not total.

The acknowledgment in the Office Action of June 21, 2005 that the disclosure shows utility in treating pain is an admission that the disclosure enables a reduction or suppression ( inhibition ) of pain. Reconsideration and withdrawal of the rejection are therefore respectfully requested.

The rejection of claim 35 under 35 U.S.C. §112, second paragraph, for alleged indefiniteness is also respectfully traversed. By way of explanation, the office action states: " the degree of inhibition is not defined and furthermore, it is

not clear how inhibition is being assessed following in vivo administration of the instant compounds?”

It is not necessary to define a specific degree of inhibition for the claim to be definite. The proper test of definiteness is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” If one skilled in the art is able ascertain the meaning of “inhibiting” in light of the specification, then 35 U.S.C. 112, second paragraph is satisfied. In the instant case, as evidenced by the appended dictionary definitions of “inhibit,” one skilled in the art would understand the term “inhibiting” as meaning any degree of lessening or suppression of pain.

As for the comment regarding the manner of assessment, it should suffice to point out that persons skilled in the art are well aware of a variety of standard procedures for assessing inhibition of pain, any of which could be used, and that pages 53 and 54 of the specification furthermore provide a detailed description of one useful way of assessing inhibition of pain in a mammal.

Since the meaning of “inhibiting” can be readily understood by a person skilled in the art, the requirements of 35 U.S.C. §112, second paragraph are satisfied. Reconsideration and withdrawal of the rejection are accordingly respectfully requested.

With regard to the objection to claims 1-34 as embracing non-elected subject matter, Applicants are submitting concurrently herewith a Petition under 37 C.F.R. §1.144 against the requirement for restriction within their Markush claim.

Favorable action on the application is earnestly solicited.

If there are any questions regarding this amendment or the application in general, a telephone call to the undersigned at (202) 624-2845 would be appreciated since this should expedite the prosecution of the application for all concerned.

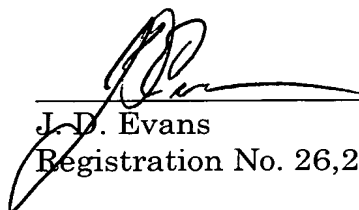
If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and

Application No. 10/644,981  
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please charge any deficiency in fees or credit any overpayments to Deposit  
Account No. 05-1323 (Docket #029310.52539US).

Respectfully submitted,

March 22, 2006

  
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REPLY TO FINAL OFFICE ACTION  
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APPENDIX

Dictionary.com Webpage of definitions  
for the word "inhibit"

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Appendix to Reply to Final Office Action



inhibit

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## 5 entries found for *inhibit*.

**in·hib·it** **Pronunciation Key** (ĩn-hĩb'ĩt)  
*tr.v.* in·hib·it·ed, in·hib·it·ing, in·hib·its

1. To hold back; restrain. See Synonyms at [restrain](#).
2. To prohibit; forbid.
3. *Psychology*. To suppress or restrain (behavior, an impulse, or a desire) consciously or unconsciously.
4.
  - a. *Chemistry*. To prevent or decrease the rate of (a reaction).
  - b. *Biology*. To decrease, limit, or block the action or function of (an enzyme or organ, for example).

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[Middle English *inhibiten*, *to forbid*, from Latin *inhibēre*, *inhibit-*, *to restrain, forbid* : *in-*, *in*; see *in-*<sup>2</sup> + *habēre*, *to hold*; see *ghabh-* in Indo-European Roots.]

**in·hib'it·a·ble** *adj.*

**in·hib'i·tive** or **in·hib'i·to'ry** (-tôr'ē, -tōr'ē) *adj.*

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Source: *The American Heritage® Dictionary of the English Language, Fourth Edition*  
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**in·hib·it** (ĭn-hĭb'ĭt)v. **in·hib·it·ed**, **in·hib·it·ing**, **in·hib·its**

1. To hold back; restrain.
2. To suppress or restrain a behavioral process, an impulse, or a desire consciously or unconsciously.
3. To prevent or decrease the rate of a chemical reaction.
4. To decrease, limit, or block the action or function of something in the body, as an enzyme or organ.

**in·hib'it·o·ry** (-tôr'ē) *adj.*

Source: The American Heritage® Stedman's Medical Dictionary  
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Main Entry: **in·hib·it**

Pronunciation: in-'hib-&amp;t

Function: *transitive verb*

**1 a** : to restrain from free or spontaneous activity especially through the operation of inner psychological or external social constraints <an *inhibited* person> **b** : to check or restrain the force or vitality of <*inhibit* aggressive tendencies>

**2 a** : to reduce or suppress the activity of <a presynaptic neuron can not only excite a postsynaptic neuron but can also *inhibit* it —H. W. Kendler> **b** : to retard or prevent the formation of **c** : to retard, interfere with, or prevent (a process or reaction) <*inhibit* ovulation>

Source: Merriam-Webster's Medical Dictionary, © 2002 Merriam-Webster, Inc.

**inhibit**

v 1: to put down by force or authority; "suppress a nascent uprising"; "stamp down on littering"; "conquer one's desires" [syn: suppress, stamp down, subdue, conquer, curb] 2: limit the range or extent of; "Contact between the young was inhibited by strict social customs"

Source: WordNet ® 2.0, © 2003 Princeton University

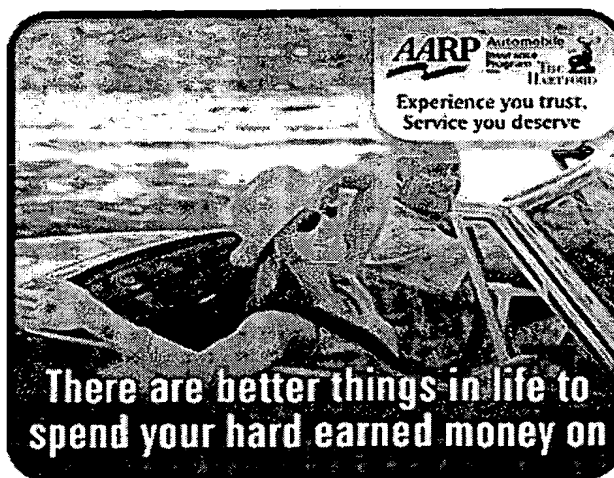
**inhibit**inhibit: in CancerWEB's On-line Medical Dictionary

Source: On-line Medical Dictionary, © 1997-98 Academic Medical Publishing & CancerWEB

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